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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,194	05/14/2001	Oomman Painumoottil Thomas	KCC-15,893	8181

7590 12/03/2002

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

7

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/855,194

Applicant(s)

THOMAS, OOMMAN  
PAINUMOOTIL

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 29-37, 39-42, 44-48 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28, 38, 43 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-28, 38, 43 and 49 in Paper No. 6 is acknowledged.

### ***Information Disclosure Statement***

2. The information disclosure statement filed June 5, 2001, paper #2 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because there are missing references and/or no translation/English abstracts of the foreign documents. The references that are missing and/or have no English translation have been crossed out on the PTO 1449. The IDS has been placed in the application file, but the information referred to therein has not been fully considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1772

4. Claims 15, 16, 18 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15, 16, 18 and 24 are indefinite because they fail to set forth the composition or structure of the elastomeric strands and only claim properties of the “exhibit different amounts of elastic tension.” Claims that merely set forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 7-19, 21-25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Melbye et al. (5,681,302).

Melbye discloses an elastic sheet composite comprising a first flexible sheet (elastomeric film/facing sheet), a plurality of elongate elastic strands, and a second flexible sheet (elastomeric film/facing sheet) (figure 6). The elastic sheet composite provides advantages when used for many purposes particularly including being incorporated in disposable garments such as diapers,

Art Unit: 1772

training pants, or adult incompetence briefs (col. 1, lines 43-47). The first and second flexible sheet can be made of different thermoplastic polymers, spunbonded nonwoven fibers which are stretchable (col. 1, lines 56-59 and examples 1, 2 and 5). The elongate elastic strands comprise a thermoplastic material (col. 1, lines 63-67). From figures 2 and 6 the strands can be seen to have even spacing and the same diameter. Melbye also discloses and shows in figure 8 one of many possible variations in the spacing and diameters of the strands that can cause the elastic sheet composite when stretched longitudinally of its strands to be under greater or lesser tensions across its width normal to the strands depending on the spacing and or diameters of the strands.

7. Claims 1, 3, 8-19 and 21-28 are rejected under 35 U.S.C. 102(b) as being anticipated by St. Louis et al. (5,993,433).

St. Louis discloses an absorbent article with enhanced elastic design for improved aesthetics and containment for conventional absorbent article, such as disposable diapers waistbands and elasticized leg bands or leg cuffs (col. 1, lines 14-16). The absorbent article comprises a first fabric layer, a first layer of elastic members, a gasket flap barrier layer, a second layer of elastic members, and a second layer of fabric (figures 9-11).

The elastic members, may have any variety of configurations. For example, the width of the individual elastic members may varied from about 0.08 mm to about 25 mm or more. The elastic members may comprise a single strand of elastic material, or may comprise several parallel or non-parallel strands of elastic material, and the elastic members may be applied in a rectilinear or curvilinear arrangement. Where multiple strands are employed, the individual strands may be constructed to provide different elastic forces. For example, the individual strands may be of different diameter or other size, or may be configured with different amounts

Art Unit: 1772

of elongation to thereby provide a gradient or other variation of elastic tensions. See column 10, lines 26-50.

The gusset flap barrier can be composed of different thermoplastics (col. 13, lines 7-36). The fabric layer can be composed of polypropylene spunbond materials (col. 13, lines 38-53).

***Claim Rejections - 35 USC § 102/103***

8. Claims 38, 43 and 49 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Melbye et al. (5,681,302) or St. Louis et al. (5,993,433).

Melbye and St. Louis disclose all the limitations of the instant claimed invention as described above.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable

Art Unit: 1772

even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation directed to the process of making the elastomeric laminate is a method of production and therefore does not determine the patentability of the product itself.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melbye et al. (5,681,302) in view of Sauer (<sup>6,527,300</sup>~~5,573,300~~).

Melbye discloses all the limitations of the instant claimed invention except for either the elastomeric strand material or elastomeric film material made comprising a thermoset polymer, the strand material and the film material are the same, and the elastomeric strands have different compositions.

Sauer discloses an absorbent article for incontinence garment or disposable diapers (col. 1, lines 17-26). The absorbent article comprises a plurality of elastic strands which can be composed of synthetic thermoplastic elastomers, or thermoset polymers (col. 18, lines 8-21).

It would have been obvious to one of ordinary skill in the art to use thermoset material as the stands in Melbye because Sauer discloses that they ate equivalent materials for use in the art. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the

Art Unit: 1772

invention was made to use a thermoset material for the elastomeric film material, the same material for both the strands and the film, or have different compositions for the strands, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use.

### *Conclusion*

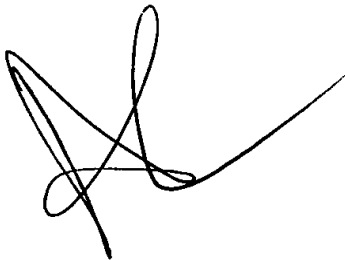
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays


If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

11/24/02



  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1/12  
11/25/02